

REMARKS

Claims 38-45 are pending. Claim 46 was cancelled. This Response is filed in response to the Office Action mailed on December 18, 2002.

In the Office Action, the Examiner rejected claims 38-45 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-11 of US Patent No. 6161543 (Cox). Applicants traverse the rejection.

Obviousness-type double patenting requires rejection of an application claim when the *claimed* subject matter is not patentably distinct from the *claims* of the patent in question. See MPEP §804 II.B.1 (page 800-22 (8th ed. rev. 1)). In this case, the claimed subject matter of the application is patentably distinct from the claims of the Cox patent. The sole independent claim of Cox, claim 1, reads as follows:

A method of ablating epicardial tissue around the pulmonary veins,
comprising the steps of:

providing at least one ablation device having at least one ablating element;

introducing the ablation device into the patient's chest;

positioning the ablating element in contact with a location *on an epicardial surface of the heart*; and

ablating tissue to form a lesion *around the pulmonary veins* with the at least one ablating element positioned at the location on the epicardial surface to form at least part of the lesion around the pulmonary veins.

Note that claim 1 of Cox requires forming a lesion *around the pulmonary veins* with the at least one ablating element *positioned at the location on the epicardial surface* to form at least part of the lesion around the pulmonary veins. As is shown below, pending independent claim 38 (and dependent claims 39-45) do not claim ablating an epicardial surface; nor do they claim ablating around the pulmonary veins. Claim 38 is presented below.

38. A method of forming a lesion in heart tissue of a patient, comprising:
providing an electrophysiological ablating device comprising at least one electrode;
creating an opening in a patient's chest, the opening passing through the chest wall
and into the patient's thoracic cavity;
passing the electrode through the opening;
positioning the electrode adjacent to heart tissue; and
ablating the heart tissue with the electrode to create a lesion in the heart tissue while
the heart is beating.

Further, claim 38 includes, among other differences, a step that Cox does not claim: "ablating the heart tissue with the electrode to create a lesion in the heart tissue *while the heart is beating*." Not one of the claims in Cox describe this step. Similarly, claims 39 and 40 claim steps that Cox does not claim. Applicants submit that claims 38-40 of the pending application, and the claims that depend therefrom are patentably distinct from claims 1-11 of Cox as the claims of Cox would not have rendered claims 38-45 obvious to one of ordinary skill in the art.

The Examiner has, for each of the pending claims, pointed out in the specification of Cox where the elements of the pending claims find support. It is well-settled, however, that "[w]hen considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, *the disclosure of the patent may not be used as prior art*." MPEP §804 II.B.1 (page 800-22 second column); General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1280-81 (Fed. Cir. 1992). As a result, reliance on the specification of the Cox patent is not appropriate. Applicants respectfully submit the obviousness-type double patenting rejection over the Cox patent is obviated, and request it be withdrawn.

Applicants request that the Examiner contact the undersigned if a discussion of the issues would advance the prosecution of the application.

Respectfully submitted,

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